

### **REMARKS**

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested.

By this Amendment, claims 1, 16-19, and 21 are amended and claims 7 and 20 are canceled. Accordingly, claims 1-6 and 8-19, and 21 remain pending in the application. No new matter is presented in this Amendment.

### **Claim Objections**

The Patent and Trademark Office (PTO) objects to claim 7 because of informalities. Applicants amend claim 7 to replace the word "inserting" with "inverting" as suggested by the Examiner to obviate the objection thereto. Accordingly, withdrawal of the objection to claim 7 is respectfully requested.

### **Claim Rejections under 35 USC 101**

Claims 1-15, 20 and 21 stand rejected under 35 USC 101 as not falling within one of the four statutory categories of invention. In response, the claims are amended and are believed to be directed to statutory subject matter for the reasons discussed below.

The Federal Circuit has indicated that the test of patentability is whether the claimed method is: (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. (*See In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (CAFC 2008)). In our opinion, the current set of claims meets at least the transformation test for patentable subject matter.

As amended, claim 1 recites, *inter alia*, "generating a compensated image, compensating, if necessary, for visual differences between the synthetically generated textual patterns and images being compared against the synthetically generated patterns," (emphasis added). Applicants respectfully submit that at least this step transforms an image of a page to a compensated form, based upon visual differences.

Similarly, claim 21 is amended to recite "generating a compensated image," and likewise recites patentable subject matter.

Based at least upon the amendments to independent claims 1 and 21, Applicants respectfully submit that independent claims 1 and 21, and claims 2-15 that depend from

claim 1, are patentable subject matter under 35 USC 101. Accordingly, withdrawal of this rejection is respectfully requested.

### **Claim Rejections**

Claims 1-3 and 10-19 stand rejected under 35 U.S.C. §102(b) as being anticipated by Kopec et al. (US 5,883,986). In addition, claims 4-9 and 20-21 stand rejected variously under 35 USC 103(a) as being unpatentable over Kopec in view of one or more of Dennis et al. (US 6,285,802 B1), Li et al. (US 6,470,092 B1), and Burke et al. (US 6,351,660 B1).

Applicants gratefully acknowledge the indication that the combination of claims 1, 7, and 20 would distinguish the claims over the applied references. Therefore, claim 1 is amended to include the allowable subject matter of claims 7 and 20, and claims 7 and 20 are herewith canceled. Furthermore, independent claims 16-19 and 21 are likewise amended to include the distinguishing subject matter of claims 7 and 20.

Accordingly, based upon the foregoing amendments, independent claims 1, 16-19, and 21, and dependent claims 2-6 and 8-15 that depend variously therefrom, are distinguished over all allowable combinations of the applied references and withdrawal of the rejections over the applied art is respectfully requested.

**Conclusion**

In view of the foregoing, it is respectfully submitted that claims 1-6, 8-19, and 21 are allowable and that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claim 1-6, 8-19, and 21 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in cursive script, reading "Kenneth M. Berner".

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